



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,580	11/01/2001	Yoon Kean Wong	035451-0166 (3704.Palm)	2720
26371	7590	05/09/2006	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/001,580	Applicant(s) WONG ET AL.	
	Examiner Pierre E. Elisca	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-20,22 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-20,22 and 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendment filed on 02/21/2006.
2. Claims 1, 2, 5-20, 22 and 24-29 are pending.
3. The rejection to claims 1, 2, 5-20, 22 and 24-29 under 35 U.S.C 103 (a) as being unpatentable over Mitsugi in view of Kakiyara as set forth in the office action mailed on 1/23/2005 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 5-7, 8, 9, 15, 18 10-14, 16-20, 22 and 24-29 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Mitsugi (U.S. Pat. No. 5,353,023) in view of Kakiyara et al (U.S. Pat. No. 6,959,282).**

As per claims 1, 6, 7, 8, 9, 15, 18, 10, 16, 17, 18, and 24-29 Mitsugi substantially discloses a car (or object) navigation system that is adapted to be installed on a car for estimating a location of the car or object, detecting

Art Unit: 3621

occurrence of an accident and performing communication data, a location unit for generating car location (or object location) (which is seen to read as Applicant's claimed invention wherein said wireless communications system at the same location as the object, the system comprising:

An object (or CAR) that is insured or capable of being insured by the insurance product (see., abstract, col 1, lines 44-68, col 2, lines 37-48);

A wireless communications system at the same location as the object (see., abstract, col 1, lines 44-68, col 2, lines 37-48, col 3, lines 43-68, col 4, lines 41-54, figs 1A-3);

A location determining system associated with the object (or CAR) and capable of determining the object's location at any time (see., abstract, col 1, lines 44-68, col 2, lines 37-48, col 3, lines 43-68, col 4, lines 41-54, figs 1A-3);

A data collection system configured to collect data at predetermined intervals from the location determining system, the data including a present location of the object determined from the location determining device (see., abstract, col 1, lines 44-68, col 2, lines 37-48, col 3, lines 43-68, col 4, lines 41-54, figs 1A-3, specifically fig 1A, items 100 and 300).

Mitsugi fails to explicitly disclose wherein said **the pricing system configured to price or sell the insurance product (or company), based on the data (or based on the location of the object or car)**.

However, Kakiyara discloses a **toll (or price)** collection arrangement based on the position and travel of a vehicle. A charging information for the vehicle is created

Art Unit: 3621

based on the position of a moving body as well as buffer areas and map information, then even if there are detection errors in the detection of the position of the vehicle (see., abstract, col 2, lines 42-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the navigation system for cars of Mitsugi by including an insurance product or company that is connected to the navigation system as taught by Kakiyama Murakami since it is an alternate means for acquiring insurance information about the location of a car/object.

As per claims 2, 12, 13, 14, 20 and 22 Mitsugi discloses the claimed limitation, wherein the price system is in electronic communication with the data collection system via wireless transmitter (see., abstract, col 1, lines 44-68, col 2, lines 37-48, col 3, lines 43-68, col 4, lines 41-54, figs 1A-3, specifically fig 1A, items 100 and 300).

As per claims 5, 11 and 19 Mitsugi discloses the claimed limitation, wherein the data relating to the product is data relating to at least one selected operational parameter, temperature, humidity, hours of operation, and time between service [see., abstract, col 1, lines 44-68, col 2, lines 37-48, col 3, lines 43-68, col 4, lines 41-54, figs 1A-3, specifically fig 1A, item 100, the car location estimated unit, for estimating traveling (hourly) information].

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 02/21/2006 have been fully considered but they are not persuasive.

REMARKS

7. Applicant respectfully submits that, any proper combination of Mitsugi and Kakihari fails at least one limitation:

a. "pricing system in communication with the data collection system, the pricing system configured to price or sell the insurance product, based on the data". As discussed in the previous rejection and hereby incorporated by reference. Mitsugi fails to explicitly disclose wherein said **the pricing system configured to price or sell the insurance product (or company), based on the data (or based on the location of the object or car)**.

However, Kakihara discloses a toll collection arrangement based on the position and travel of a vehicle. A charging information for the vehicle is created based on the position of a moving body as well as buffer areas and map information, then even if there are detection errors in the detection of the position of the vehicle (see., abstract, col 2, lines 42-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the navigation system for cars of Mitsugi by including an insurance product or company that is connected to the navigation system as taught by

Art Unit: 3621

Kakihara Murakami since it is an alternate means for acquiring insurance information about the location of a car/object.

Moreover, Mitsugi discloses in col abstract, col 1, lines 44-68, col 2, lines 37-48 a navigation system for informing an accident to liaison offices, organizations. The Examiner interprets the liaison offices or organizations to be included insurance policy, premium or hospital or liability etc. Therefore, Applicants arguments are not persuasive, and accordingly, the rejection is hereby sustained.

b. Applicant also maintains that Mitsugi and Kakihara cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App & Inter);

and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

Conclusion

8. Prior art U.S. Pat. No. 6,083,353 Alexander, Jr.

Prior Art U.S. Pat. No. 5,842,148 Prendergast et al.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3621

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

May 2, 2006